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COSTCO WHOLESALE CORPORATION

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA

12 DECKERS OUTDOOR
13 CORPORATION, a Delaware
Corporation,

14 Plaintiff,

15 |

16 COSTCO WHOLESALE
17 CORPORATION, a Washington
Corporation; and DOES 1-10, inclusive,

18 | Defendant.

Case No. 2:25-cv-04174-MCS-AGR

Judge: The Hon. Mark C. Scarsi

**DEFENDANT COSTCO
WHOLESALE CORPORATION'S
REPLY IN SUPPORT OF MOTION
TO DISMISS PLAINTIFF'S FIRST
AMENDED COMPLAINT
PURSUANT TO FED. R. CIV. P.
12(b)(6)**

Hearing:

Date: September 15, 2025

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1 **I. INTRODUCTION**

2 Deckers is notorious for attempting to extend intellectual property protection
3 to its shoes based on alleged unregistered trade dress. As Deckers is well aware, the
4 Supreme Court and courts in this district discourage such “abuse of trade dress law,”¹
5 as the proper vehicle to obtain IP rights over footwear is *registering* trade dress or a
6 design patent.² Of course, registering IP protection requires USPTO examination.
7 Registering trade dress, in particular, requires a *showing* that the footwear has attained
8 secondary meaning, which even Deckers’ most famous UGG® boot lacked.

9 Knowing it cannot make the proper secondary meaning showing, Deckers
10 circumvents these established processes through filing hundreds of federal lawsuits
11 (about 200 in the Central District) for alleged unregistered trade dress infringement,
12 recycling boilerplate allegations across ten different shoes. Deckers thus believes it
13 can escape any scrutiny concerning whether its footwear warrants IP protection—at
14 least through summary judgment and/or coerced settlement with “competitors” like
15 Costco, Wal-Mart, and hundreds of others—arguing that its conclusory, factually bare
16 secondary meaning allegations survive a 12(b)(6) motion. Deckers is incorrect, and
17 the Court should not countenance its attempt to avoid scrutiny on secondary meaning.

18 **II. RELEVANT FACTS RELIED ON BY DECKERS**

19 Deckers’ scant nine lines on “factual background” (Opp. 3:11-19) state it is
20 “one of the biggest footwear companies in the United States,” with brands like
21 UGG®, founded 1979, and Costco sells “a wide range of products” through (member-
22 only) retail stores and online at www.costco.com. (*Id.*, citing FAC, ¶¶8-9, 18, 19, 21.)
23 Deckers mentions other conclusory allegations in passing (Section IV.1, *infra*; Opp.
24 3:11-19, 11:1-6, 12:11-20, citing FAC, ¶¶8-16, 18, 19, 21, 23, 28-33), but abandons

25 ¹ See Mot. 15 (*Deckers Outdoor Corp. v. Wal-Mart Stores, Inc.*, No. 2:20-CV-
26 09521-FLA (EX), 2024 WL 2208099, at *10 (C.D. Cal. Apr. 9, 2024) (discussing
Wal-Mart Stores, Inc. v. Samara Bros., 529 U.S. 205, 212–13 (2000)).

27 ² Per *Samara Bros.*, copyright protection is also available for original designs, but
28 the design of a shoe itself is a useful article, not copyrightable. U.S. Copyright
Office, *COMPENDIUM OF U.S. COPYRIGHT OFFICE PRACTICES* § 924.2 (3d ed. 2021)
(discussing *Star Athletica, LLC v. Varsity Brands, Inc.*, 137 S. Ct. 1002 (2017)).

1 other allegations (e.g. inherent distinctiveness) for reasons noted in the Motion.
2 Decker's bare-bones "factual background" section, traditionally where a plaintiff
3 recites the facts alleged in the complaint that state a claim for relief, speaks volumes.

4 Notably, while Deckers laments that Costco seeks judicial notice of "extrinsic
5 evidence" relied on in the FAC (e.g. five articles Deckers directly quotes, Dkt. 26,
6 RJN Exs. 16-20) or otherwise properly noticeable (e.g. Deckers' other complaints,
7 *id.*, Exs. 11-15), Deckers argues facts in opposition beyond the FAC:

- 8 • In its first paragraph, Deckers argues it "sued Costco in 2023 for
9 selling knockoffs of its famous UGG® Classic Ultra Mini Boot"
10 (Opp. 1:6-8), i.e. a prior case not alleged in the FAC (settled by
11 confidential agreement without admission of liability).
- 12 • In the second, Deckers argues that "customers and the media have
13 frequently referred to Costco's lookalike products as low-cost 'look
14 alike' or 'copies' of Deckers' distinctive designs." (Opp. 1:18-20).

15 On both points, Deckers does not cite the FAC, as there is no such allegation.

16 **III. DECKERS INCORRECTLY ARGUES THAT THE FAC REQUIRES**
17 **NO SUBSTANTIVE FACTS TO SURVIVE A MOTION TO DISMISS**

18 Unable to allege more than threadbare conclusions, Deckers misstates the legal
19 standard, ignoring that: (i) the *Twombly/Iqbal* pleading standard requires sufficient
20 fact allegations, not bald conclusions; (ii) courts routinely adjudicate the sufficiency
21 of secondary meaning allegations at the pleading stage; and (iii) facts subject to
22 judicial notice and incorporation-by-reference may be considered per Rule 12(b)(6).

23 Deckers' arguments misapprehend the law; alleging some plausible facts does
24 not allege "enough facts to state a claim to relief that is plausible on its face." *Bell*
25 *Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). While "[w]hether a mark has
26 obtained secondary meaning is question of fact to be determined by a jury" (Opp.
27 2:11-13, citing *Miller v. Glenn Miller Prods., Inc.*, 454 F.3d 975, 991 (9th Cir. 2006)³

28

³ Deckers also cites two decisions by this Court not addressing secondary meaning.

1 (denying summary judgment), on a motion to dismiss, the Court generally accepts the
2 factual matter alleged as true and decides whether those facts suffice to plead
3 secondary meaning, as shown by the plethora of cases cited in the Motion. (Mot. at
4 9:3-16; *see also, Hot Focus Inc. v. Best Accessory Grp. LLC*, 2022 WL 3013032, at
5 *7-8 (C.D. Cal. June 23, 2022) (secondary meaning presents “question of fact,” but
6 plaintiff failed to allege sufficient facts on relevant factors).) Hence, the fact-intensive
7 nature of the secondary meaning inquiry does not exempt Deckers from pleading facts
8 to make it plausible.

9 The Court may also consider judicially noticed materials without error, per
10 Costco’s concurrently-filed Reply ISO its RJN. In any event, the Court need not rely
11 on contested exhibits to grant the Motion, as Deckers’ deficient factual allegations do
12 not plausibly allege secondary meaning.

13 **IV. DECKERS’ CONCLUSORY ALLEGATIONS LACK FACTS**
14 **RENDERING SECONDARY MEANING PLAUSIBLE**

15 **1. Deckers’ Bare Legal Conclusions and Meaningless Qualifiers**
16 **Cannot Support Secondary Meaning.**

17 Instead of pleading facts on secondary meaning, i.e. the “mental association by
18 a substantial segment of consumers... between the alleged trade dress and a single
19 source” (Mot. 7:16-8:6 [citation omitted]), Deckers uses patently conclusory or
20 otherwise meaningless general qualifiers, i.e.:

21 (1) Deckers spent “substantial time, effort, and money in designing,
22 developing, advertising, promoting, and marketing” Tasmans, and as a result,
23 sold millions of dollars of Tasmans (Opp. 6:20-22, citing FAC, ¶13);

24 - The FAC is devoid of factual allegations that would supply meaning to
25 the otherwise meaningless qualifier “substantial”; further, Deckers refuses to
26 elaborate on its sales, perhaps only a few hundred pairs per year (Mot. 9-10).

27
28 (Opp. at 2, n.2; *Daniels v. Specialized Loan Servicing, LLC*, 2023 WL 4291651, at *3
(C.D. Cal. Apr. 20, 2023) (contract-related claims adequately pled).)

(2) “[A] large volume of unsolicited media attention, for example, through various celebrities seen wearing the UGG® Tasman and [being] featured in many magazines nationwide and internationally” (Opp. 11:1-6, citing FAC, ¶10-16, 28-32);

- Deckers cites alleged “unsolicited mediation attention,” but demands that the Court not consider the five articles actually cited in the FAC, which raise serious doubt about secondary meaning (Mot., *e.g.* p. 11, n. 3).

(3) “Deckers spends millions of dollars annually on advertising of UGG® products, including” Tasmans (Opp. 11:1-6, citing FAC, ¶¶10-16, 28-32);

- This allegation is not specific to Tasmans, allowing the reasonable inference that little to no UGG®-brand advertising is specific to that shoe (Mot., pp. 2-3, 5, 9-12, etc.).

(4) Coscto's "close copying of the UGG® Tasman," purportedly "to exploit Deckers' goodwill" (Opp. 12:11-20, citing FAC, ¶¶23, 33);

- This allegation relies solely on the alleged visual similarity between the shoes, without any facts to support Deckers' legal conclusion of intentional copying to trade off any claimed trade dress (Mot., pp. 8-9, 14-16, n.4).

19 Deckers' allegations thus feature bare, general conclusions, not facts (*see, e.g.*,
20 Opp. pp. 6-7). Indeed, allegations that Deckers has "substantial" advertising/sales,
21 received "widespread" media coverage, or even faced "deliberate copying" of the
22 Tasman design by others are not sufficient to support a claim of secondary meaning.

Indeed, the Tasman is nowhere near the iconic footwear designs registered by the USPTO, e.g. Louboutin’s red sole or Adidas’s three-stripe trade dress. 1
25 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:7 (5th ed.). In contrast to these registered footwear designs, Deckers has not even attempted to register the trade dress for any shoes after its applications to register its most famous shoe’s trade dress were rejected. (Mot. 12-14; RJD Exs. 5-8.)

1 Deckers concededly has made no attempt to register its Tasman trade dress, and
2 so never made the factual showing on secondary meaning required. Nor has it ever,
3 in hundreds of cases filed to date, proved any of its shoes' trade dress has secondary
4 meaning. Deckers' failure to show secondary meaning for any of its products, in any
5 proceeding, in any forum, highlights the importance of factual allegations rendering
6 secondary meaning plausible, which it does not have.

2. Deckers Could Plead Non-Confidential Sales Figures, Image Advertising, or a Secondary Meaning Survey, But Does Not.

9 Deckers nonsensically asserts its Tasman sales figures are “confidential,”
10 requiring filing under seal. (Opp. 8, n. 6.) Deckers does not explain why sales figures
11 (units sold or revenue, as opposed to profits), are confidential. The very cases Deckers
12 cites make clear that general sales figures are not confidential and should be provided
13 to support secondary meaning. *See Givenchy S.A. v. BCBG Max Azria Grp., Inc.*
14 (“*Givenchy*”), No. CV 10-8394-GHK SHX, 2012 WL 3072327, at *5, n.7 (C.D. Cal.
15 Apr. 25, 2012) (trade dress generated “in excess of \$20 millions of revenue... for
16 Givenchy since 2006.”); *adidas Am., Inc. v. Skechers USA, Inc.*, 890 F.3d 747, 752
17 (9th Cir. 2018) (adidas sold “more than 40 million pairs” of Stan Smith shoes, earns
18 “several hundred million dollars in annual domestic sales of [three-stripe] products”).
19 A plaintiff who bears the burden of plausibly alleging secondary meaning cannot hide
20 behind a bare assertion of “confidentiality” as to the amount and exclusivity of sales
21 (particularly unit volumes), which is the lynch pin of secondary meaning.

22 Likewise, Deckers' arguments as to its failure to allege *any* image advertising
23 miss the mark, as it cites cases in which a plaintiff did image advertising without
24 "look-for" callouts but ensured claimed design features were "prominently visible."
25 (*Cf.* Opp. 13-14, quoting *Givenchy*, at *5; *see also id.*, discussing *Adidas-Salomon AG*
26 *v. Target Corp.*, 228 F. Supp. 2d 1192, 1209 (D. Or. 2002) ("what type of image
27 advertising is required" not critical, as "adidas has done some image advertising.")).
28 Deckers does not point to a single allegation in the FAC as to any advertising showing

1 the Tasman, whether “look-for” ads or just image advertising showing Tasmans at all,
2 let alone in a way fostering association with trade dress features. The complete
3 absence of such allegations distinguishes Deckers’ FAC from its cited authorities,
4 including the Ninth Circuit case misleadingly cited to argue trade dress recognition
5 does not require “explicitly instructing consumers to ‘look for’ it” (Opp. 13:12, citing
6 *Jason Scott Collection, Inc. v. Trendily Furniture, LLC*, 68 F.4th 1203, 1216 (9th Cir.
7 2023), *cert. denied*, 144 S. Ct. 550 (2024).) To be clear, that *Trendily* case does not
8 mention “look-for” advertising at all, let alone indicate it is unnecessary. Costco’s
9 Motion directs the Court to the correct Ninth Circuit authority requiring “look-for” or
10 at least “image” advertising per *First Brands* (Mot. 3, 10-11; 809 F.2d 1378 (9th
11 Cir.1987)). A handful of out-of-circuit decisions not requiring “look-for” advertising
12 do not help where Deckers failed to allege image advertising of any kind.

13 Finally, Deckers doubles down on its inapposite “survey from a prior lawsuit”
14 (Opp. 6:25-26), i.e. a not-yet-admitted⁴ survey from a *pending* case that concededly
15 does not test for secondary meaning. Deckers ignores the critical distinction between
16 an *Eveready* survey and evidence of actual confusion, only the latter of which is
17 probative of secondary meaning. That distinction cannot be overlooked, because an
18 *Eveready* survey is not direct evidence of actual confusion, and is unavoidably leading
19 on secondary meaning. (Mot. 16, RJD Ex. 21: “What company do you believe makes
20 or puts out these slippers?” [assumes exclusivity]). In short, even if Deckers’ survey
21 is ultimately accepted elsewhere, that alleged survey testing for consumer confusion
22 cannot support secondary meaning, at the pleading stage or otherwise.

23 **3. Deckers Does Not Allege Facts Relied On Elsewhere To Deny**
24 **A Motion To Dismiss, Including Deliberate Copying.**

25 Deckers asks this Court to overlook the dearth of factual allegations in the FAC

26

27 ⁴ Deckers has never proved secondary meaning in hundreds of cases; its only
28 secondary meaning survey Costco is aware of was stricken “as methodologically
flawed.” *Deckers Outdoor Corp. v. Wal-Mart Stores, Inc.*, No. 2:20-CV-09521-
FLA (EX), 2024 WL 2208099, at *9 (C.D. Cal. Apr. 9, 2024) (Fluff Yeah).

1 to plausibly allege secondary meaning for two reasons: (1) plaintiffs have survived
2 dismissal with skimpier factual allegations; and (2) Deckers' bald reference to "close
3 copying" suffices to allege secondary meaning. Neither argument has merit.

4 First, Deckers' attempt to minimize its own pleading burden lacks merit. (Opp.
5 7:2-8:2 [arguing no "specific allegation" of secondary meaning is needed, only
6 pleading "generally"].) Deckers' cited case law, however, does not permit its
7 threadbare allegations to pass muster: for example, *Solid Host, NL v. Namecheap, Inc.*, 652 F.Supp.2d 1092, 1108 (C.D. Cal. 2009) was a cybersquatting case dealing
8 with a trademark, *not* unregistered product trade dress. There, the court found
9 allegations sufficient to plead secondary meaning where a hacker purposefully stole
10 a domain including a trademark to profit, raising an inference of distinctiveness. *Id.*
11 at 1107-08. The Court cannot make a similar inference here, both because the FAC
12 lacks concrete facts supporting it, and because it is contrary to the Supreme Court's
13 direction in *Samara Bros* to scrutinize unregistered trade dress to avoid monopoly.
14

15 Next, Deckers erroneously claims that complaints with "even *less* detail" have
16 survived dismissal (Opp. 9:26-27), citing, *e.g.*, *Homeland Housewares, LLC v. Euro-*
17 *Pro Operating LLC*, 2015 WL 476287 *4 (C.D. Cal. Feb. 5, 2015). There, however,
18 the court initially denied plaintiff's motion for preliminary injunction for failure to
19 show secondary meaning. 2014 WL 4187982, *8 (C.D. Cal. Aug. 22, 2014)
20 ("Homeland has not pointed to any evidence of the effectiveness of its advertising in
21 creating a secondary meaning for its trade dress other than providing the dollar figure
22 of its overall advertising budget...."). After amendments, the Court considered the
23 sufficiency of the second amended complaint, in which plaintiff supplemented to add
24 facts regarding pervasive marketing of its trade dress; defendant's intent to create a
25 copycat product; and defendant's subsequent use of false, comparative advertising to
26 undermine plaintiff's product. *See* 2014 WL 10122074 (second amended complaint).
27 In denying dismissal, the Court considered one exemplary allegation, concluding:
28 "These allegations are *probably* sufficient, at the pleading stage, to state a claim based

1 on secondary meaning.” 2015 WL 476287, at *4 (italics added). Deckers’ cited cases
2 do not vindicate its vaguely-alleged FAC.

3 Second, Deckers’ threadbare allegation of “close copying” cannot salvage its
4 inability to plead secondary meaning (Opp. 6:6-15; FAC, ¶23). *See Kittrich Corp. v.*
5 *United Indus. Corp.*, 2017 WL 10434389, at *6 (C.D. Cal. Oct. 18, 2017) (conclusory
6 allegation that defendants “willfully and intentionally mimicked the EcoSmart trade
7 dress” did not suffice to allege secondary meaning); *Deckers Outdoor Corp. v.*
8 *Fortune Dynamic, Inc.*, 2015 WL 12731929, at *5 (C.D. Cal. May 8, 2015) (granting
9 motion to dismiss for failure to allege secondary meaning where “[t]he allegations of
10 intentional copying are[] conclusory”); *S&B Filters, Inc. v. ETN Cap., LLC*, 2022 WL
11 2204144, at *3 (C.D. Cal. Mar. 9, 2022) (same); *Hot Focus Inc.*, 2022 WL 3013032,
12 at *7-8 (same); *see also Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837,
13 844 (9th Cir. 1987) (deliberate copying may not be probative of secondary meaning
14 because there are legitimate reasons for competitors to copy non-protectable features).

15 None of Deckers’ cited authority shows otherwise, i.e. that alleged similarities
16 alone permit the Court to assume deliberate copying; instead, all cases cited included
17 additional evidence that the purchasing public associated the trade dress with plaintiff.
18 *See Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 611, 615 (9th Cir. 1989)
19 (affirming preliminary injunction; defendant began selling clothing copying logo
20 months after plaintiff declined to sell to defendant; considered with survey evidence
21 and copycat advertising campaign); *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251
22 F.3d 1252, 1264 (9th Cir. 2001) (secondary meaning evidence defeated summary
23 judgment; defendant’s employees sought to copy the look of the alleged pool hall
24 trade dress, and inspected plaintiff’s pool hall for that purpose; with survey evidence);
25 *P & P Imps. LLC v. Johnson Enters., LLC*, 46 F.4th 953, 961-62 (9th Cir. 2022)
26 (secondary meaning evidence defeated summary judgment where defendant ordered
27 plaintiff’s game, sent it to manufacturer, then sold nearly identical game months later
28 with copycat marketing; with survey evidence); *Jason Scott Collection, Inc. v.*

1 *Trendily Furniture, LLC*, 68 F.4th 1203, 1214-16 (9th Cir. 2023) (at trial, court
2 properly considered conceded copying of direct competitor's furniture pieces as one
3 factor showing secondary meaning, with, *e.g.*, consumer recognition evidence).

4 No case holds that a conclusory allegation of "close copying," supported solely
5 by alleged visual similarities of two products, suffices to allege secondary meaning at
6 this stage. Otherwise, asserting that a "competitor"⁵ copied products per purported
7 similarities would plausibly allege secondary meaning in all instances. It does not, as
8 *Samara Bros.* prohibits such abuse of trade dress law.

9 **4. Deckers Abandoned UCL Attorneys' Fees and the Tasman,**
10 **Changing Trade Dress Elements for the "Tasman II".**

11 Costco noted that Deckers "has only sold a new and different 'Tasman II' since
12 before filing this case" (Mot. 1:4-7), to which Deckers responds that the Tasman and
13 Tasman II "are virtually identical" (Opp. 18:13-15), i.e. not the same. While Deckers
14 frames this transition as a mere "name-change," the core issue is that the shoe itself
15 has changed, specifically in how claimed trade dress elements appear. Deckers'
16 argument that both shoes embody the Tasman Trade Dress is outside the pleadings,
17 and the FAC's failure to identify the Tasman II dooms that shoe's secondary meaning.

18 Lastly, Deckers concedes it "is not seeking fees under California common law,"
19 so the motion to dismiss attorneys fees sought on that UCL claim must be granted.

20 **V. CONCLUSION**

21 Deckers need not plead *every* fact relevant to secondary meaning, but it cannot
22 avoid pleading *any* facts on this critical issue. Because Deckers fails to plead the
23 requisite facts, its unregistered trade dress does not merit monopoly protection.

24
25
26
27 ⁵ Costco sells shoes but is not Deckers' "competitor." Costco is a warehouse store
28 selling thousands of items to its members; it does not manufacture shoes or sell
through other retailers (as Deckers does). The court need not accept as true
conclusory allegations contrary to facts judicially noticed, or indeed, common sense.

1 Dated: August 27, 2025

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CERTIFICATE OF COMPLIANCE

The undersigned, counsel of record for Defendant Costco Wholesale Corporation, certifies that this brief contains 2,974 words, which:

4 X complies with the word limit of L.R. 11-6.1.

5 X complies with the 3,000-word limit set by the Court's Standing Order
6 (9.d.) dated May 13, 2025 (Dkt. 8).

7 Counsel relies on the word count of the word-processing application used to
8 prepare the brief.

10 | Dated: August 27, 2025

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